

Application No. 10/003,912  
Amendment dated June 22, 2004  
Reply to Office Action of January 22, 2004

## **REMARKS / ARGUMENTS**

Applicant thanks the Examiner for the Office Action of January 22, 2004. This Amendment is in full response thereto. Applicant respectfully points out that the Office Action incorrectly identifies the date of Applicant's last response as "October 27, 2003". Pursuant to 37 CFR 1.8(a), Applicant's response should be accorded a date of October 22, 2003. Applicant thanks the Examiner for his attention to this matter.

### **The Restriction Between Groups I, II and III Should Be Withdrawn**

Applicant acknowledges the Examiner's maintenance of the Restriction Requirement of September 22, 2003. Applicant previously timely traversed the Requirement and retains the right to petition the Commissioner to withdraw the Requirement. Applicant again traverses the Requirement for the reasons given in Applicant's response of October 22, 2003. Additionally, Applicant provides comments in response to the Examiner making the Restriction Requirement final.

a) Regarding the subcombination-combinations of Groups I and II-III, Applicant is not aware of any case law precedent requiring a subcombination and combination to be in the same category of invention. Indeed, USPTO restriction practice policy, as embodied in MPEP Section 806.05(c), recognizes that subcombinations and combinations may be in different statutory categories, while at the same time be considered subcombinations and combinations. Thus, the Examiner's reason for maintaining the Restriction Requirement between Group I and Groups II-III is not well founded. Moreover as described in that Section, PTO restriction practice requires the Examiner in such a situation to show that *both* applicable criteria (different statutory categories and combination-subcombination) for distinctness must be demonstrated to support a restriction requirement. Since the Examiner has not made such a demonstration, the Restriction Requirement between Group I and Groups II-III should be withdrawn for this reason, too. Finally, since the Examiner did not require a restriction

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between Group IV and Groups II, III, Group IV should also be examined if the Restriction Requirement between Group I and Groups II, III is withdrawn.

b) Regarding the legal basis for the Restriction Requirement of Groups I and IV, the Examiner's original basis for such a Restriction was that Groups IV and I were related as process of making and *product made*. In the January 22, 2004 Office Action, the Examiner now insists that Groups IV and I are related as process of using and product. Applicant respectfully asserts that it is improper to change the basis for a Restriction Requirement while at the same time making it final, because it prevents Applicant from exercising his right to timely traverse it before it is made final. Applicant again respectfully points out that the hydrogen and nitrogen gases of the Faber-Bosh process are used to make an *ammonia compound* product, not a heat transfer fluid mixture comprising a combination of *elemental gases*.

c) Regarding the Restriction Requirement between Groups II and III, the Examiner's argument that Applicant's argument is moot in light of his election is improper under USPTO Restriction practice. USPTO Restriction practice, as embodied in MPEP Section 821.01, requires the Examiner to address Applicant's arguments concerning the non-elected claims if he has traversed the Requirement. Regarding the Species Election between direct and indirect heat transfer, the Examiner's "mootness" argument is similarly improper. Applicant respectfully asserts out that the Examiner may not properly ground this particular Requirement between Groups II and III upon points a) and b) in the January 22, 2004 Office Action. Applicant kindly points out that points a) and b) do not address a Requirement between Groups II and III, and therefore are not relevant to this specific legal issue. As such, the Restriction should be withdrawn.

Applicant has amended claims 1-7 to claim a heat transfer fluid mixture consisting essentially of argon and hydrogen. However, in light of the Examiner's Restriction Requirement and the prior art rejections, Applicant reserves the right

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to prosecute in this application, or in a divisional or continuation, the subject matter of claims 8-57 as originally presented. More specifically, Applicant reserves the right to prosecute in this application, or in a divisional or continuation, the originally presented claims 8-57 that were not limited to argon and hydrogen.

#### **Rejections under 35 USC §102**

In the January 22, 2004 Office Action, the Examiner rejected claims 1-7 under 35 USC §102 as being anticipated under a number of different references. Applicant respectfully traverses these rejections because the references fail to disclose, teach or suggest a heat transfer fluid mixture consisting essentially of argon and hydrogen.

Additionally, Applicant respectfully asserts that new claims 58-65 are patentable over the references cited by the Examiner because they fail to disclose, teach or suggest all the limitations of the claims, namely: 1) a heat transfer fluid mixture consisting essentially of helium and a heavy gas selected from the group consisting of nitrogen, carbon dioxide, and mixtures thereof; or 2) a heat transfer fluid mixture consisting essentially of hydrogen and carbon dioxide, wherein the hydrogen has a concentration ranging from about 60 mole percent to about 95 mole percent.

In conclusion and for the reasons detailed above, Applicant respectfully asserts that the application is in condition for allowance. Applicant earnestly solicits early allowance of the same.

Should the Examiner believe that a telephone call would expedite prosecution of the application, he is invited to call the undersigned attorney at the number listed below. A Petition for a two month extension of time and a fee payment for additional claims introduced by this Amendment are being contemporaneously submitted with this Amendment. Otherwise, it is believed that no fee is due at

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this time. If that belief is incorrect, please debit deposit account number 01-1375. Also, the Commissioner is authorized to credit any overpayment to deposit account number 01-1375.

Respectfully submitted,



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**CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8(a)**

I hereby certify that this correspondence is being transmitted via facsimile to telephone number 703-872-9306 on this 22nd day of June, 2004.



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